



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,249	04/13/2004	Brian Keith Long	000479.00124	5753
22909 7590 02/13/2008 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER				
CLEMENT, MICHELLE RENEE				
ART UNIT		PAPER NUMBER		
3641				
MAIL DATE		DELIVERY MODE		
02/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/824,249

**Applicant(s)**

LONG, BRIAN KEITH

**Examiner**

Michelle (Shelley) Clement

**Art Unit**

3641

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-42, 44-61 and 64-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-42, 44-61, 64-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 11/2/07 have been fully considered but they are not persuasive. In response to applicant's contention that claims 50 and 51 were not addressed in the previous Office Action, applicant is clearly mistaken. Although it appears to be a typographical error that the claim numbers were left out of the initial sentence (of ¶ 11 of the Office Action) the elements of claims 50 and 51 are clearly addressed in the rejection of ¶ 1 (Skottowe discloses in combination with the structure recited in independent claim 38 "[t]he frame is positioned adjacent one of the interior surface and the exterior surface." ¶ 1, lines 18 and 19 OA dated 8/8/07 and "[t]he units define a ceiling, a floor, and walls of the modular structure" lines, 21 and 22)) and the claim number (50 and 51) are also listed as rejected on PTO form 326 (Office Action Summary), if applicant was unclear as to the inconsistency, applicant should have contacted the examiner within the statutory 30 days for clarification. Claims 50 and 51 (written in independent form) do not overcome the previous rejection of prior cited art of Skottowe. Furthermore, applicant's submission of Wardill under 37 C.F.R. 1.97 has necessitated the new grounds of rejection on claims 50 and 51. In response to applicant's contention that Skottowe does not disclose "each of the frame portions being secured to at least one of the armored panels to form discrete units, at least some of the units having a curved configuration", it is noted that the combination of armored panels (13) and frame portions (12) render at least some of the units having a curved configuration.
2. In response to applicant's argument's concerning the Mueller reference, it is noted that the wall of Mueller (comprising elements 22, 41 and 72) constitutes a single armored panel, it is

well known in the art for an armored panel to be made of several layers, yet the panel still constitutes a single element. Therefore, the panel forms a portion of an interior and exterior surface of the modular structure and there are no voids between the interior and exterior surface (see figure 8). The fact that Mueller discloses the panel additionally comprising a composite armor panel is irrelevant, in that Mueller discloses the claimed invention.

3. Applicant's remaining arguments have been considered but are moot in view of the new ground(s) of rejection as necessitated by applicant's amendments and submission of art un 37 C.F.R. 19.7.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 38, 39, 42, 44-48, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Skottowe (UK Patent GB 22345069). Skottowe discloses a modular structure comprising a frame formed from a plurality of frame portions (references 12, 14, 15, 17 and page 2, ¶ 4) and a shell formed from a plurality of abutting armored panels (reference 13) and the shell forming at least a portion of an interior (reference 10) and exterior (reference 9) surface of the modular structure, each of the frame portions being secured to at least one of the armored panels to form discrete units, the units joinable to form the modular structure having a first configuration, the units are joinable to form modular structures having any desirable shapes (see abstract), therefore the units are interchangeable with units from other modular structures having at least a second

configuration. The modular structure can be joined with another modular structure to form a larger modular structure. Portions of the armored panels are removable from an interior to form ports. The armored panels comprise a fiber-reinforced polymer, para-aramid fiber (i.e. Kevlar). At least one of the units is hinged to form an entry point. At least one of the units includes an attachment area for mounting weaponry. The frame is positioned adjacent one of the interior surface and the exterior surface. The units define a ceiling, a floor, and walls of the modular structure. The structure comprising a base, at least three armored sides, connected to the base and substantially perpendicular to the base, wherein the at least three armored sides form at least a portion of both the interior surface and exterior surface, an open end including a means for coupling, wherein the means for coupling mates with a corresponding portion of a means for coupling on a second modular structure and wherein the base, the at least three armored sides and the open end form a self-supporting structure. Wherein one of the at least three sides is removable during use of the modular structure. Wherein two modular structures are joinable. The [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re* Pearson, 181 USPQ 641; *In re* Yanush, 177 USPQ 705; *In re* Finsterwalder, 168 USPQ 530; *In re* Casey, 512 USPQ 235; *In re* Otto, 136 USPQ 458; *Ex parte* Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte* Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

5. Claims 50 and 51 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Skottowe (UK Patent GB 22345069). Skottowe discloses a modular structure comprising a frame formed from a plurality of frame portions (references 12, 14, 15, 17 and page 2, ¶ 4) and a shell formed from a plurality of abutting armored panels (13) and the shell forming at least a portion of an interior (reference 10) and exterior (reference 9) surface of the modular structure, each of the frame portions being secured to at least one of the armored panels to form discrete units, the units joinable to form the modular structure having a first configuration, the units are joinable to form modular structures having any desirable shapes (see abstract), therefore the units are interchangeable with units from other modular structures having at least a second configuration. **The frame is positioned adjacent one of the interior surface and the exterior surface. The units define a ceiling, a base (i.e. floor), and walls of the modular structure (page 2 ¶).**

6. Claims 50 and 51 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wardill (US Patent # 4,221,426). Wardill discloses a modular structure comprising a frame formed from a plurality of frame portions (references 10, 11, 12) and a shell formed from a plurality of abutting panels (1 and 2) (which may contain metal mesh, i.e. armor) and the shell forming at least a portion of an interior and exterior surface of the modular structure, each of the frame portions being secured to at least one of the armored panels to form discrete units, the units joinable to form the modular structure having a first configuration, the units are joinable to

form modular structures having any desirable shapes (see abstract), therefore the units are interchangeable with units from other modular structures having at least a second configuration. The frame is positioned adjacent one of the interior surface and the exterior surface. The units define a ceiling, a floor, and walls of the modular structure (figure 7).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38, 40, 41, 49, 52, 54, 55, 58, 59 64, 67, 68 71, 74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (US Patent # 4,351,558) in view of Schroth (US Patent # 7,210,707) and Carter (US Patent # 5,971,177). Mueller discloses a modular structure comprising a frame formed from a plurality of tubular frame portions and a shell formed from a plurality of abutting armored panels the shell forming at least a portion of an interior and exterior surface of the modular structure. An interior surface and an exterior surface of the modular structure has no void between the interior surface and exterior surface and a portion of the modular structure includes a curved configuration. Each of the frame portions being secured to at least one of the armored panels to form discrete units, the units being joinable to form the modular structure in any desired configuration, it is inherent that the units are interchangeable with units from other modular structures; some of the units have a curved configuration. A frame (reference 30) extends around the exterior surface of the modular structure. Schroth teaches floor mounted helicopter seats having a four point harness. Carter teaches a portable crane mounted to

a truck. All of the component parts are known in the Mueller, Schroth and Carter. The only difference is the combination of the "old elements" into a single device by mounting them into the modular structure. Thus it would have been obvious to one having ordinary skill in the art to secure the seats within the modular structure and include a mounting area for the crane, since the operation of the crane and seat is in no way dependent on the operation of the other equipment of the structure to achieve the predictable results of the individual elements. The references disclose the claimed invention except for the armored material comprising a para-aramid polymer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the specific material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 1125 USPQ 416. The [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.



Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

8. Claims 38, 39, 42, 46, 47, 52, 53, 56, 57, 60, 65, 66, 69, 70, and 72-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danhof et al. (US Patent # 6,076,328) in view of Paz et al. (US Patent # 6,250,222). Danhof et al. discloses a modular structure comprising;

a frame formed from a plurality of frame portions (fig 21); and

a shell formed from a plurality of abutting sheet metal panels (reference 50a-50i)(i.e.

armored panels), each of the abutting panels forming at least a portion of an interior and exterior surface of the modular structure, having no void between the interior surface and the exterior surface;

each of the frame portions being secured to at least one of the panels to form discrete units (fig 14), at least some of the units having a curved configuration, the units having the ability (i.e. configured and aligned) to form the modular structure in a first configuration, and the units having the ability of being separable to disassemble the modular structure (if it can be assembled, it can be disassembled), wherein the units have the ability (i.e. are configured and aligned) to be interchangeable with units from other modular structures in at least a second configuration, wherein the first configuration is different from the second configuration (i.e. the individual units have the ability to be interchanged with other individual units to form a different configuration). The modular structure has the ability (i.e. is configured) to be joined with another modular structure to form a larger modular structure or a second modular structure. A portion of the panels (reference 46a and 46b) have the ability (i.e. are configured) to be removed from an

interior of the modular structure to form ports and are hinged to form an entry point of the modular structure. The frame and shell has the ability (i.e. is configured) to form an elongate shape with a first end area and an opposite second area. The modular structure further comprising at least three steel (i.e. armored) sides. With regards to claim 72 and 73, leaving one of the sides off would constitute a means for coupling because that side could be extended in a different configuration using any one of the disclosed connectors. The base, the at least three armored sides and the open end form a self-supporting structure. One of the at least three sides has the ability (i.e. is configured) to be removed during use of the structure. With regards to claims 74 and 64-71, the modular structure comprises a first frame formed from a plurality of frame portions; a first shell formed from a plurality of steel panels (i.e. armored panels), the first frame and first shell forming a first modular section having a bottom surface, a top surface and at least three sides and forming a first elongate structure, each of the panels forming the first shell forms at least a portion of the interior surface and exterior surface of the first modular section having no void between the interior surface and the exterior surface, any of the disclosed connectors comprising first coupling means arranged on the first modular section and having the ability (i.e. configured) for joining the first modular section with at least one other modular section. Any number of the units can be built and with the modularity of the units they have the ability (i.e. are configured) to be joined. Danhof et al. does not expressly teach joining the sheds or configuring the sheds into a different configuration, Paz et al. teaches an extendible shed (i.e. modular structure) in which the discrete units are joined in a variety of configurations in order to customize the size and shape of the shed. It would have thus been obvious to one having ordinary skill in the art to reconfigure the modular structure of Danhof et al. into any size or

shape desired by the user of the product to achieve the claimed invention because a person of ordinary skill would have been motivated to combine the teaching of changing configurations of size and shape as taught by Pas et al. and there would have been a reasonable expectation of success. The [a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby" clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device does, not what a device is. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on Wardill prompted the new ground(s) of rejection presented

in this Office action on claims 52 and 53. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle (Shelley) Clement/  
Primary Examiner, Art Unit 3641